

**Remarks**

**I. General**

Claims 1-4 , 6-34, and 36-47, and 62-63 are pending in this application. Claims 5, 35, and 48-61 have been cancelled. Claims 62 and 63 are newly added. Independent claim 1 has been amended to include the limitations of original claim 5 and to further clarify the invention by further reciting “subscriber” subsystems. Independent claim 33 has been amended to include the limitations of original claim 35 and to further clarify the invention by further reciting “subscriber” subsystems. No new matter has been added.

- Claims 1, 6, 8-12, 14, 22, 33, 34, 36, 37, and 42 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication 2002/007713 A1 to Spaling et al. (hereinafter “Spaling”).
- Claims 2 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of U.S. Patent Publication 2004/0203714 A1 to Van Lieshout et al. (hereinafter “Van Lieshout”).
- Claims 3 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of U.S. Patent Publication 2002/0196749 A1 to Eyuboglu et al. (hereinafter “Eyuboglu”).
- Claims 4, 40, and 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of U.S. Patent Publication 2002/0174441 A1 to Marin et al. (hereinafter “Marin”).
- Claims 5, 28-32, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling.
- Claims 7, 8, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of U.S. Patent 6,275,990 B1 to Dapper et al. (hereinafter “Dapper”).

- Claims 15-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of U.S. Patent Publication 2002/0126704 A1 to Cam et al. (hereinafter “Cam”).
- Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Cam and further in view of U.S. Patent Publication 2003/0043738 A1 to Barsheshet (hereinafter “Barsheshet”).
- Claims 23-27, and 43-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of U.S. Patent Publication 2003/0161386 A1 to Schilling (hereinafter “Schilling”).
- Claim 41 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Barsheshet.
- Claim 46 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Schilling and further in view of Barsheshet.

Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein.

## **II. Rejection Under 35 U.S.C. § 102(e)**

Claims 1, 6, 9-12, 14, 22, 33-34, 36-37, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Spaling.

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim.” *See* M.P.E.P. § 2131; *citing In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, “[t]he identical invention must be shown in as complete detail as is contained in

the . . . claim.” See M.P.E.P. § 2131; citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claim 1, as amended, recites “a first subscriber subsystem disposed at a subscriber location” and a “second subscriber system disposed at said subscriber location.” In the Current Action, the Examiner notes that Spaling discloses a Radio Network Controller (“RNC”) and a Base Station (“BS”). See Current Action, pg. 3. However, Applicant submits that neither of Spaling’s RNC or BS are subscriber stations, as set forth in claim 1. Also, Spaling’s RNC and BS are not both “disposed at a subscriber location” as also set forth in claim 1. As shown above, Spaling does not teach every limitation of Applicant’s invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 1, as amended, also recites “wherein said first subscriber subsystem comprises an indoor unit subsystem and said second subscriber subsystem comprises an outdoor unit subsystem.” The Examiner acknowledges that Spaling “does not disclose that the RNC is an indoor unit and the base station is an outdoor unit.” See Current Action, pg. 9. But, the Examiner opines that having an RNC as an indoor unit and a base station as an outdoor unit is old and well known in the art. *Id.* As noted above, Spaling does not teach either of a first subscriber subsystem or a second subscriber subsystem. As such, Applicant notes that even if the Examiner is correct, which Applicant does not concede as true, the rejection is of no consequence. Spaling’s RNC and BS are not subscriber subsystems as set forth in claim 1. Therefore, even if an indoor RNC and outdoor BS were known in the art, the claim limitation would not be satisfied. For these reasons, namely that Spaling’s RNC and BS are not subscriber subsystems and Spaling does not disclose an indoor unit and an outdoor subscriber subsystem, claim 1 is patentable in view of the art of record. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 33, as amended, recites “said first subscriber subsystem disposed at a subscriber location” and “said second subscriber subsystem disposed at said subscriber location.” Applicant notes that Spaling discloses an RNC and BS. However, as mentioned above with respect to claim 1, neither of these items are subscriber subsystems. Further, Spaling’s RNC and BS are not both disposed at a subscriber location, as also set forth in

claim 33. As shown above, Spaling does not teach every limitation of Applicant's invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 33, as amended, also recites "wherein said first signal processing subscriber subsystem comprises an indoor unit and said second subscriber signal processing subsystem comprises an outdoor unit." The Examiner acknowledges that Spaling "does not disclose that the RNC is an indoor unit and the base station is an outdoor unit." *See* Current Action, pg. 9. But, the Examiner opines that having an RNC as an indoor unit and a base station as an outdoor unit is old and well known in the art. *Id.* As noted above, Spaling does not teach either of a first subscriber subsystem or a second subscriber subsystem. As such, Applicant notes that even if the Examiner is correct, which Applicant does not concede as true, the rejection is of no consequence. Spaling's RNC and BS are not subscriber subsystems as set forth in claim 1. Therefore, even if an indoor RNC and outdoor BS were known in the art, the claim limitation would not be satisfied. For these reasons, namely that Spaling's RNC and BS are not subscriber subsystems and Spaling does not disclose an indoor unit and an outdoor subscriber subsystem, claim 33 is patentable in view of the art of record. Therefore, Applicant requests withdrawal of the rejection of record.

Claims 6, 9-12, 14, and 22 depend from claim 1 and claims 34, 36, and 37 depend from claim 33, respectively. Each dependent claim inherits every limitation of the claim from which it depends. As shown above, Spaling does not teach every limitation of claims 1 and 33. As such, claims 6, 9-12, 14, 22, 34, 36, and 37 are patentable at least through their dependency on claims 1 and 33. Moreover, the dependent claims set forth additional limitations not taught by Spaling.

For example, claim 6 recites "wherein said first subscriber subsystem provides only digital processing of said subscriber data." Applicant notes that Spaling's RNC (which the Examiner equates to a first subscriber system) provides DHO 54, which performs functions such as radio resource control algorithms relating to handover procedures and diversity connections. *See* Spaling at paragraph [0047]. As shown above, Spaling does not teach every limitation of Applicant's invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 10 recites “wherein said second subscriber subsystem provides all analog processing of said subscriber data provided by said system.” Applicant notes that Spaling does not teach this limitation. Spaling, at paragraph [0048] shows its base station (which the Examiner equates to a second subscriber station) performing digital processing. As shown above, Spaling does not teach every limitation of Applicant’s invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 11 recites “wherein said second subscriber subsystem comprises a frequency converter for conversion between an intermediate frequency and a radio frequency.” Applicant notes that Spaling does not teach this limitation. Spaling, at paragraph [0048] merely shows its base station having channel processor that perform spreading and de-spreading operations. As shown above, Spaling does not teach every limitation of Applicant’s invention. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 12 recites “wherein said second subscriber subsystem comprises at least one amplifier.” Applicant notes that Spaling does not teach this limitation. Spaling, at paragraph [0048] merely shows its base station having power controller performing power control operations based on its own measurements and messages received from the RNC and/or base station. However, there is no teaching that the power controller controls an amplifier, as the Examiner suggests. Therefore, Applicant requests withdrawal of the rejection of record.

### **III     Rejections Under 35 U.S.C. 103(a)**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding that the first or second criteria are satisfied, the Applicant respectfully asserts that the Examiner’s rejection fails to satisfy the third criteria.

- A. Claims 2 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Van Lieshout.

Claim 2 depends from claim 1 and claim 38 depends from claim 33, respectively. As shown above, Spaling does not teach or suggest every limitation of claims 1 and 33. Moreover, Van Lieshout is not relied upon to teach or suggest the missing limitations, nor does it do so. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- B. Claims 3 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Eyuboglu.

Claim 3 depends from claim 1 and claim 39 depends from claim 33, respectively. As shown above, Spaling does not teach or suggest every limitation of claims 1 and 33. Moreover, Eyuboglu is not relied upon to teach or suggest the missing limitations, nor does it do so. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- C. Claims 4, 40, and 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Marin.

Claim 4 depends from claim 1, and claims 40 and 47 depend from claim 33, respectively. As shown above, Spaling does not teach or suggest every limitation of claims 1 and 33. Moreover, Marin is not relied upon to teach or suggest the missing limitations, nor does it do so. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- D. Claims 5, 28-32, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling.

As an initial matter, please note that claims 5 and 35 have been cancelled. However, claims 28-32 depend from claim 1 and inherit every limitation therefrom. As shown above, Spaling does not teach or suggest every limitation of claim 1. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- E. Claims 7, 8, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Dapper.

Claims 7, 8, and 13 depend from claim 1 and inherit every limitation therefrom. As shown above, Spaling does not teach or suggest every limitation of claim 1. Moreover, Dapper is not relied upon to teach or suggest the missing limitations, nor does it do so. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- F. Claims 15-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Cam.

Claims 15-20 depend from claim 1 and inherit every limitation therefrom. As shown above, Spaling does not teach or suggest every limitation of claim 1. Moreover, Cam is not relied upon to teach or suggest the missing limitations, nor does it do so. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- G. Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Cam and further in view of Barsheshet.

Claim 21 depends from claim 1 and inherits every limitation therefrom. As shown above, Spaling does not teach or suggest every limitation of claim 1. Moreover, Barsheshet is not relied upon to teach or suggest the missing limitations, nor does it do so. As such,

these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- H. Claims 23-27, and 43-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Schilling.

Claims 23-27 depend from claim 1 and claims 43-45 depend from claim 33, respectively. As shown above, Spaling does not teach or suggest every limitation of claims 1 and 33. Moreover, Schilling is not relied upon to teach or suggest the missing limitations, nor does it do so. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- I. Claim 41 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Barsheshet.

Claim 41 depends from claim 33 and inherits every limitation therefrom. As shown above, Spaling does not teach or suggest every limitation of claim 33. Moreover, Barsheshet is not relied upon to teach or suggest the missing limitations, nor does it do so. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.

- J. Claim 46 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spaling in view of Schilling and further in view of Barsheshet.

Claim 41 depends from claim 33 and inherits every limitation therefrom. As shown above, Spaling does not teach or suggest every limitation of claim 33. Moreover, neither of Barsheshet or Schilling is relied upon to teach or suggest the missing limitations, nor does they do so. As such, these claims set forth limitations not taught or suggested by the Examiner's proposed combination. Therefore, Applicant requests withdrawal of the rejection of record.



**IV     Conclusion**

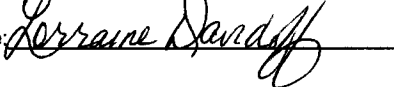
In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 68144/P007US/10501224 from which the undersigned is authorized to draw.

Dated: September 19, 2006


I hereby certify that this correspondence is being electronically filed with MS-Amendments, Commissioner for Patents, through EFS web filing.

Date of Electronic Filing: September 19, 2006

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